

Internal distribution code:

- (A) Publication in OJ
(B) To Chairmen and Members
(C) To Chairmen
(D) No distribution

D E C I S I O N
of 20 January 2004

Case Number: T 0749/02 - 3.4.3

Application Number: 91310565.6

Publication Number: 0486318

IPC: H01L 21/58

Language of the proceedings: EN

Title of invention:

Semiconductor device for use in a light valve device, and process for manufacturing the same

Applicant:

SEIKO INSTRUMENTS INC.

Opponent:

-

Headword:

Late filed amendments/SEIKO

Relevant legal provisions:

EPC Art. 84, 123(2), 113(2), 111(1)

EPC R. 86(3), 67, 51(4), (5)

RPBA Art. 10

Guidelines C-VI 4.9

Keyword:

"Procedural violation (yes) - decision issued by the formalities officer not empowered to decide"

"Procedural violation (yes) - discretion under Rule 86(3) exercised without reasoning"

"Remittal (no) - discretion under Article 111(1) EPC"

"Reimbursement of the appeal fee (yes)"

Decisions cited:

G 0007/93, T 0182/88, T 0237/96, T 0295/01, T 0360/91

Catchword:-



Case Number: T 0749/02 - 3.4.3

D E C I S I O N
of the Technical Board of Appeal 3.4.3
of 20 January 2004

Appellant:

SEIKO INSTRUMENTS INC.
31-1, Kameido 6-chome
Koto-ku
Tokyo 136 (JP)

Representative:

Sturt, Clifford Mark
Miller Sturt Kenyon
9 John Street
London WC1N 2ES (GB)

Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted refusing
European application No. 91310565.6 pursuant to
Article 97(1) EPC.

Composition of the Board:

Chairman: R. K. Shukla
Members: G. L. Eliasson
M. B. Günzel

Summary of Facts and Submissions

I. This appeal lies from the decision of the Examining Division dated 28 February 2002 refusing the European patent application No. 91 310 565.6 under Article 97(1) EPC. The ground for the refusal was that there was no text agreed by the applicant (Article 113(2) EPC).

II. The relevant facts of the case leading to the decision to refuse the application in suit can be summarized as follows:

(a) At the oral proceedings held on 10 December 1998, the Examining Division informed the applicant that it intended to grant a patent on the basis of the applicant's auxiliary request filed during the oral proceedings.

According to the minutes of the oral proceedings, the Examining Division informed the applicant that the main request filed with the letter dated 10 November 1998 did not meet the requirements of Articles 84 and 123(2) EPC. In particular, independent method claim 7 according to the main request was considered to be not clear, since whereas it defined a method of producing a device according to claim 1 of the main request, the method steps of claim 7 produced a different device from that of claim 1.

(b) In a communication under Rule 51(4) EPC issued on 20 April 1999, the Examining Division informed the applicant of its intention to grant a patent on

the basis of the auxiliary request filed at the oral proceedings.

- (c) Claim 1 according to the auxiliary request which was considered allowable by the Examining Division has the following wording:

"1. A process of manufacturing a semiconductor device, comprising:

a first step of forming an SOI substrate by depositing an insulating film of silicon dioxide on a surface of a temporary silicon substrate, thermally bonding a semiconductor substrate of single crystal silicon on a surface of the insulating film, and polishing the semiconductor substrate to form a single crystal semiconductor thin film;

a second step of forming a semiconductor integrated circuit in the single crystal semiconductor thin film;

a third step of fixedly adhering a support substrate in face-to-face relation to a surface of the semiconductor integrated circuit opposite to the temporary substrate;

a fourth step of removing the temporary substrate to expose a surface of the insulating film to the outside; and

a fifth step of subjecting the exposed surface of the insulating film to a treatment including at least forming an electrode."

- (d) With the letter of 15 October 1999, the applicant did not give his consent to the documents proposed for grant. Instead, the applicant filed amended claims 1 to 6 with amended pages of the description, and requested the grant of a patent with the above amended documents.
- (e) In a communication dated 3 December 1999, the primary examiner of the Examining Division informed the applicant that the new claims filed with the letter dated 15 October 1999 were not admitted under Rule 86(3) EPC, since (i) they were filed late, i.e. after the issue of the communication under Rule 51(4) EPC, and (ii) since claim 1 did not comply with Article 84 EPC for the reasons discussed during the oral proceedings. It was therefore suggested that the applicant withdraws his request.
- (f) Following a confirmation by the applicant that he maintained the request dated 15 October 1999, the decision under appeal was issued. The decision was signed by the formalities officer on behalf of the Examining Division and referred to the communication dated 3 December 1999 containing the reasons for not admitting the amended claims.

III. The appellant (applicant) lodged an appeal on 22 April 2002, paying the appeal fee the same day. A statement of the grounds of appeal was filed on 25 June 2002.

IV. In a communication dated 6 September 2002, the Board informed the applicant that since the decision to refuse the application was signed by the formalities officer who was not empowered to issue such a decision, it could be regarded ab initio null and void. It would therefore be justified to remit the case back to the department of the first instance without examination of the substantive issue in the appeal, and to reimburse the appeal fee.

In response, the applicant requested that the Board should examine the appeal without remitting the matter to the Examining Division.

V. The applicant requests that the decision under appeal be set aside and a patent be granted on the basis of the following documents:

Claims:

Nos. 1 to 6 filed with the letter dated 15 October 1999;

Description:

Pages 12 and 13 filed with the letter dated 15 October 1999
pages 1 to 11, 14 to 55 as specified in the communication under Rule 51(4) EPC dated 20 April 1999

Drawings:

Sheets 1/19 to 19/19 as originally filed

Oral proceedings are requested in the event that the Board does not allow the above request.

VI. Claim 1 according to the above request differs from the wording of claim 1 which was annexed to the communication under Rule 51(4) EPC in that (amendments have been emphasised by the Board)

"a first step of forming an SOI substrate by **depositing an insulating film of silicon dioxide** on a surface of a temporary silicon substrate"

is replaced with

"a first step of forming an SOI substrate by **forming an insulating film** on a surface of a temporary silicon substrate".

VII. The reasons given by the Examining Division in its communication dated 3 December 1999 for not admitting further amendments under Rule 86(3) EPC were essentially as follows:

- (a) According to the Guidelines for Examination C-VI, 4.9, the communication under Rule 51(4) EPC does not constitute an opportunity for the applicant to call into question of an earlier procedure, since at this stage, the substantive examination has been completed. Thus, only amendments, such as obvious errors, which do not appreciably delay the preparations for grant, will be accepted.
- (b) A *prima facie* analysis of claim 1 indicates that it does not meet the requirements of Article 84 EPC for reasons which were also discussed at the oral proceedings before the Examining Division.

VIII. The applicant presented essentially the following arguments in support of his request:

(a) In exercising its discretion to refuse to admit amendments under Rule 86(3) EPC, the Examining Division did not (i) consider all relevant facts, (ii) take regard to the applicant's interest in obtaining an adequate protection for his invention, (iii) exercise its discretion in accordance with the right principles, and (iv) exercise its discretion in a reasonable way.

(b) As the amendments proposed by the applicant in response to the Rule 51(4) communication concern two non-essential features of the invention and as these amendments are clearly allowable, refusal by the Examining Division to admit the amendments was unreasonable, and was not according to the right principles as set out in G 7/93, T 182/88 and T 237/96.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is therefore admissible.

2. *Procedural matters and remittal*

As mentioned above (see item II(f) above), the decision under appeal was *signed* by a formalities officer on behalf of the Examining Division. Since the present case falls under Rule 51(5), second sentence EPC

(version of Rule 51 in force until 30 June 2002), it was beyond the competence of a formalities officer to issue such a decision (cf. "Notice of the Vice-President Directorate General 2 of the European Patent Office dated 28 April 1999 concerning the entrustment to non-examining staff of certain duties normally the responsibility of the examining or opposition divisions" (OJ EPO 1999, 504; reproduced in "Ancillary Regulations of the EPC, 2002", R. 9(3))). The decision has therefore to be regarded a nullity (cf. T 295/01, OJ EPO 2002, 251, point 7 of the reasons), even though, as is apparent from the fact that the file contains an unreasoned order refusing the application signed by all the members of the Examining Division on Form 2048.2, the formalities officer had possibly acted on the instructions from the Examining Division.

According to Article 10 of the Rules of Procedure of the Boards of Appeal, a board shall remit a case to the department of the first instance if fundamental deficiencies are apparent in the first instance proceedings unless special reasons present themselves for doing otherwise. In the present case, the appellant requested that the Board should decide on the substantive issues in the appeal without remitting the case (cf. item IV above). As the Board is able to decide in favour of the appellant, a remittal of the case would in the Board's view have unduly delayed the procedure to the detriment of the appellant (cf. e.g. T 360/91 of 2 December 1991, points 4 and 9 of the reasons).

3. *Discretion to admit amendments under Rule 86(3) EPC*

In the present case, the Examining Division exercised its discretion under Rule 86(3) EPC to refuse the amendments filed by the applicant with the letter dated 15 October 1999, with the result that the application in suit was refused on the ground that there was no text agreed by the applicant. The appellant has in the statement of the grounds of appeal argued that the Examining Division exercised its discretion in an unreasonable way.

3.1 Following decision G 7/93 (OJ EPO 1994, 775), when an appeal is lodged against the way in which the discretion was exercised, a Board of Appeal should only overrule the way in which a first instance department had exercised its discretion if it comes to the conclusion either that the Examining Division had not exercised its discretion in accordance with the right principles or that it had exercised its discretion in an unreasonable way, and had thus exceeded the proper limits of its discretion (cf. point 2.6 of the reasons).

3.2 In the present case, the request for further amendments with the letter dated 15 October 1999 was filed in response to a communication under Rule 51(4) EPC, i.e. at a stage where in normal cases the substantive examination has been completed. Although the Board in principle endorses the position held by the Examining Division in its communication of 3 December 1999 that at such late stage of the examination procedure, only such amendments which do not appreciably delay the preparations for grant of the patent should normally be allowed (cf. item VII(a) above; Guidelines C-VI, 4.9),

late-filed amendments must nevertheless be judged on a case-to-case basis and reasons must be given when no further amendments are admitted.

- 3.3 The unpublished decision T 237/96 of 22 April 1998 concerns the same issue as in the present case, i.e. the question how the discretion under Rule 86(3) EPC should be exercised when a request for further amendments was filed in response to a communication under Rule 51(4) EPC. Following the principles set out in G 7/93 it was held that "to refuse minor amendments of merely editorial nature, or amendments relating to aspects of the invention of no relevance to the assessment of the patentability of the claimed subject matter, if such amendments were clearly acceptable under Articles 84 and 123(2) EPC, may for instance not be considered reasonable of an examining division" (cf. point 2.3 of the reasons).

In the earlier unpublished decision T 182/88 of 3 November 1988, it was held that reasons for not allowing a further amendment must be given beyond merely stating that it is "late".

- 3.4 In the present case, the reasons given in the communication dated 3 December 1999 for not allowing the new claims were (i) the amendment was submitted late (after that the communication under Rule 51(4) EPC was issued) (cf. item VII(a) above); and (ii) claim 1 did not meet the requirements of Article 84 EPC in the light of discussions held during the oral proceedings (cf. item VII(b) above).

According to the minutes of the oral proceedings, the only clarity objection raised by the Examining Division was against claim 7 of the main request for the reasons that although the claimed method was for a method of manufacturing "a semiconductor device as claimed in claim 1", the method according to claim 7 did not result in the device of claim 1 (cf. item II(a) above).

Since the claims filed with the letter dated 15 October 1999 only contains method claims, the above-mentioned objection cannot apply for these claims.

Thus, the Examining Division when considering whether the claims as amended (in relation to claims which were considered to be allowable) were allowable, referred in its communication to an objection of lack of clarity which was raised earlier on in the examination procedure in relation to a different process claim. As shown above, the objection which was raised in relation to the earlier process claim is not applicable to the claims as amended, and therefore, the above communication did not contain any reasoning in respect of the claims submitted by the applicant beyond the observation that the amendments were filed at a late stage.

Thus, the exercise of the discretion against admitting the proposed amendments was not reasoned.

4. The Board has decided to exercise its power under Article 111(1) EPC to examine whether the amendments proposed with the letter dated 15 October 1999 should be admitted under Rule 86(3) EPC.

4.1 Following the criteria set out in T 237/96 mentioned above for exercising the discretion under Rule 86(3) EPC for late-filed amendments (cf. item 3.3 above), the Board comes to the conclusion that the amendments should be admitted, since firstly, the amendments do not render the claim unclear, that is, the proposed amendments neither introduce any unclear terms nor do they contradict other features of claim 1. The amendments to claim 1 have a clear basis in the description, as indicated by the applicant when filing the proposed amendments (cf. application as published, column 11, lines 23 to 30; column 19, lines 43 to 52), and it was not contended by the Examining Division that the amendments do not have a basis in the application as filed, as required by Article 123(2) EPC.

Finally, the nature of the amendments, i.e. replacement of "deposition of silicon dioxide film" by "formation of an insulating film" does not affect the assessment by the Examining Division in favour of inventive step of the claimed subject matter.

4.2 For the above reasons, the amendments proposed with the applicant's letter dated 15 October 1999 are allowed.

5. The Board finds that it is equitable to reimburse the appeal fee pursuant to Rule 67 EPC, since the appeal is allowed, and the decision under appeal was null and void for having been taken by a person not empowered to decide and moreover, since in its content it was not reasoned in the exercise of the discretion under Rule 86(3) EPC. Had the Examining Division exercised its discretion correctly and decided itself accordingly, the present appeal would not have been filed.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of the first instance with the order to grant a patent on the basis of the documents as specified under item V above.
3. Reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:

D. Meyfarth

R. K. Shukla